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10/764,470	01/27/2004	Noriko Sugimoto	2004_0109A	9151
513 7590 08/18/2009 WENDEROTH, LIND & PONACK, L.L.P. 1030 15th Street, N.W., Suite 400 East Washington, DC 20005-1503				
EXAMINER				
COPPOLA, JACOB C				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/764,470

Applicant(s)

SUGIMOTO ET AL.

Examiner

JACOB C. COPPOLA

Art Unit

3621

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. This action is in reply to the 'Amendments to the Claims' and the 'Remarks' filed on 27 April 2009 ("09 Apr Amendments" and "09 Apr Remarks," respectively).
2. Claims 15-21 are currently pending and have been examined.
3. This Office Action is given Paper No. 20090810. This Paper No. is for reference purposes only.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 16-21 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Regarding Claims 16-21

6. Claims 16-21 are directed to neither a "process" or a "machine" but rather embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101. Accordingly, claims 16-21 and are rejected under §101.

Claim Rejections - 35 USC § 112, 2nd Paragraph

7. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 16-21 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Regarding Claim 16

9. Claim 16 is indefinite because it is considered a hybrid claim. See MPEP §2173.05(p) II. In particular, the claim is directed to neither a “process” or a “machine” but rather embraces or overlaps two different statutory classes of invention as set forth in 35 U.S.C. §101.
10. For example, claim 16 recites “The system of claim 15.” Additionally, dependent claims 17-21 also state “The system of claim 1[x],” respectively. In light of this evidence, one of ordinary skill in the art could reasonably interpret these recitations as express intent by Applicants to claim a machine claim. Alternatively, claim 16 recites “the AV stream is a stream obtained by *multiplexing* a video stream” (emphasis added). One of ordinary skill in the art could also reasonably interpret these recitations as express intent by Applicants to claim a process claim. In light of this conflicting evidence, a person of ordinary skill in the art could reasonably interpret claim 16 to be drawn to either a product or process.
11. Therefore in accordance with §2173.05(p) II which states that a single claim must be drawn to either a product or process (but not both) and because a potential competitor of

Applicants would not know whether *possession alone* of the claimed structure constituted infringement, or alternatively, if infringement required the *execution* of the recited method steps (*i.e.*, the step of “multiplexing a video stream”), the claims are indefinite. If Applicants overcome this particular 35 U.S.C. §112, 2nd paragraph rejection, the related 35 U.S.C. §101 rejection will also be withdrawn.

Regarding Claim 18

12. This claim is indefinite because it is unclear to one of ordinary skill in the art whether the “server apparatus” is positively recited as a component of the claimed “system.”

13. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 15 is rejected under 35 U.S.C. §103(a) as being unpatentable over Yamada et al. (U.S. 6,141,483 A) ("Yamada"), in view of Candelore et al. (U.S. 2003/0174837 A1) ("Candelore").

Regarding Claims 15-21

16. Yamada discloses:

an optical disc having a disc region code ("region code") assigned thereto and having content recorded thereon (figs. 3 and 4, c. 3, l. 57-61, c. 7, l. 22-57, and c. 12, l. 1+); and a playback apparatus ("reproducing apparatus 2") for playing back the optical disc, wherein the playback apparatus comprises:

a processor ("control unit 11") that judges whether the disc region code assigned to the optical disc matches an apparatus region code assigned to the playback apparatus and that reads the content identifier of the content recorded on the optical disc (c. 12-13);

a memory ("recording unit 12") that stores predetermined additional data corresponding to the optical disc, wherein the predetermined additional data includes a substitute playback order of the content recorded on the optical disc and a substitute content, such that a predetermined part of the content recorded on the optical disc is capable of being replaced by the substitute content (c. 7, "rewritable data zone 23," and c. 7, l. 10-16),

the memory is distinct from the optical disc (fig. 2);

a playback unit ("control unit 11") that plays back the content when the processor judges that the disc region code matches the apparatus region code (c. 12-13); and

a transmitting unit that transmits an authorization request (c. 15).

17. Yamada does not directly disclose an optical disc having a content identifier identifying the content recorded thereon, and a processor that reads the content identifier of the content recorded on the optical disc.

18. Candelore teaches a medium having a content identifier identifying content recorded thereon, and a processor that reads the content identifier of the content recorded on the medium (figs. 3 and 4).

19. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the disc of Yamada to include content with content identifiers as taught by Candelore since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

20. Additionally, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the apparatus of Yamada to read the content identifiers as taught by Candelore. One would have been motivated to do so in order to allow regional substitution of content (Candelore, abstract).

Claim Interpretation

21. The Examiner interprets claim 15 to contain four conditional elements of the claimed invention. The following illustration is provided for clarity:

let conditional element A = “playback unit... plays back the content when the processor judges that the disc region code matches the apparatus region code” (emphasis added);

let conditional element B = “processor judges whether a combination of the content identifier read by the processor and the apparatus region code satisfies a predetermined condition defined by an owner of fights of the content when the processor judges that the disc region code does not match the apparatus region code” (emphasis added);

let conditional element C = “(i) the processor replaces the predetermined part of the content recorded on the optical disc with the substitute content of the predetermined additional data that is stored in the memory and that corresponds to the optical disc, in order to create a predetermined package, based on the substitute play back order of the predetermined additional data that is stored in the memory and that corresponds to the optical disc, and (ii) the playback unit plays back the created predetermined package when the processor judges that the combination of the content identifier read by the processor and the apparatus region code satisfies the predetermined condition defined by the owner of the rights of the content” (emphasis added), and

let conditional element D = “the playback unit does not play back the content when the processor judges that the combination of the content identifier read by the processor and the apparatus region code does not satisfy the predetermined condition defined by the owner of the fights of the content.”

22. The Examiner notes “conditional element A” and “conditional element B” are alternatives to one another and based on whether the processor judges that the disc region code matches or does not match the apparatus region code.

23. Likewise, the Examiner notes “conditional element C” and “conditional element D” are alternatives to one another and based on whether the processor judges that the combination of the

content identifier read by the processor and the apparatus region code *satisfies or does not satisfy* the predetermined condition defined by the owner of the rights of the content. However, for “conditional element C” and “conditional element D” to occur, “conditional element B” must be met.

24. Accordingly, conditional elements B, C, and D (from above) only happen when “conditional element A” is not met (*i.e.*, all three elements are alternatives to “conditional element A”). Accordingly, if a prior art reference discloses every element of claim 15 (including a playback unit and processor that meet “conditional element A”) *except for* conditional elements B, C, and D (from above), then the prior art reference anticipates claim 15.

25. Applicants are reminded that “[a]s a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.” *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006)(where the Federal Circuit affirmed the Board’s claim construction of “further including that said wall may be smooth, corrugated, or profiled with increased dimensional proportions as pipe size is increased” as non-limiting since “this additional content did not narrow the scope of the claim because these limitations are stated in the permissive form ‘may.’”). See also *e.g.* MPEP §2106 II C.: which states, “Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.” (emphasis in original).

26. With respect to claim 15, the Examiner interprets the “predetermined additional data corresponding to the optical disc, wherein the predetermined additional data includes a substitute

playback order of the content recorded on the optical disc and a substitute content” to be nonfunctional descriptive data. This recitation of nonfunctional descriptive data is not given patentable weight because it is not needed for meeting “conditional element A.”

27. With respect to claim 16, the Examiner interprets the “the content includes an AV stream, playlist information, and a dynamic scenario; the AV stream is a stream obtained by multiplexing a video stream, an audio stream, and a subtitle stream; the playlist information is information including one or more pairs of start time information and end time information in a playback time axis of the AV stream, each pair of start time information and end time information defining a playback section; the dynamic scenario is a program that causes the playback apparatus to play back the playlist information; the predetermined additional data is any of the AV stream, the playlist information, and the dynamic scenario supplied to the playback apparatus via a network; and the playback of the created predetermined package includes (i) a playback of one of an additional audio stream and an additional subtitle stream that are not recorded on the optical disc, and (ii) a playback of a playback section of the AV stream that is different from the playback section defined by the playlist information of the optical disc” to be nonfunctional descriptive data. This recitation of nonfunctional descriptive data is not given patentable weight because it is not needed for meeting “conditional element A.”

28. With respect to claim 17, the Examiner interprets the “the playlist information includes a playback authorization setting that indicates which playback of the video stream, the audio stream, and the subtitle stream is authorized or not; and the created predetermined package includes a playback authorization setting that is different from the playback authorization setting defined by the playlist information of the optical disc” to be nonfunctional descriptive data. This

recitation of nonfunctional descriptive data is not given patentable weight because it is not needed for meeting “conditional element A.”

29. With respect to claim 18, the Examiner interprets the “the authorization request indicating the combination of the content identifier read by the processor and the apparatus region code, wherein, when the predetermined condition is satisfied, the server apparatus transmits an authorization response in reply to the authorization request, and wherein, when the predetermined condition is not satisfied, the server apparatus transmits a non-authorization response” to be nonfunctional descriptive data. This recitation of nonfunctional descriptive data is not given patentable weight because it is not needed for meeting “conditional element A.”

30. With respect to claim 19, the Examiner interprets the “a playback authorization list including combinations of a content identifier and a region code, each combination indicating that a content identified by a respective content identifier is allowed to be played back in a region identified by a respective region code; and the predetermined condition is satisfied when the playback authorization list of the server includes the combination of the content identifier and the apparatus region code indicated by the authorization request transmitted by the transmitting unit” to be nonfunctional descriptive data. This recitation of nonfunctional descriptive data is not given patentable weight because it is not needed for meeting “conditional element A.”

31. With respect to claim 20, the Examiner interprets the “a plurality of pieces of date/time information, each piece of date/time information indicating, for a corresponding combination of a content identifier and a region code, a release date/time of a content identified by the content identifier for a region identified by the region code of the corresponding combination; the authorization request transmitted from the transmitting unit to the server apparatus includes a

combination of (i) a current time in a region to which the playback apparatus belongs, (ii) the content identifier of the content to be played back, and (iii) the apparatus region code; and the predetermined condition is satisfied when the current time included in the authorization request is past the release date/time indicated in a piece of date/time information for a corresponding combination of the content identifier and the region code that is the same as the combination of the content identifier and the region code included in the authorization request” to be nonfunctional descriptive data. This recitation of nonfunctional descriptive data is not given patentable weight because it is not needed for meeting “conditional element A.”

32. With respect to claim 21, the Examiner interprets the “a plurality of pieces of distributor information, each piece of distribution information indicating, for a corresponding combination of a content identifier and a region code, a distributor for a region identified by the region code of the corresponding combination; the authorization request transmitted from the transmitting unit to the server apparatus includes a combination of (i) the content identifier of the content to be played back, (ii) the apparatus region code, and (iii) the disc region code; and the predetermined condition is satisfied when a distributor indicated in a first piece of distributor information matches a distributor indicated in a second piece of distribution information, the first piece of distributor information indicating a distributor for a corresponding combination of the content identifier and the apparatus region code that is the same as the combination of the content identifier and the apparatus region code included in the authorization request, and the second piece of distributor information indicating a distributor for a corresponding combination of the content identifier and the disc region code that is the same as the combination of the content identifier and the disc region code included in the authorization request” to be

nonfunctional descriptive data. This recitation of nonfunctional descriptive data is not given patentable weight because it is not needed for meeting “conditional element A.”

33. Additionally, the Examiner notes that “the PTO and the CCPA acknowledged product-by-process claims as an exception to the general rule requiring claims to define products in terms of structural characteristics.” *Atlantic Thermoplastics Co. v. Faytex Corp.*, 970 F.2d 834, 845, 23 USPQ2d 1481, 1490 (Fed. Cir. 1992) (hereinafter “*Atlantic Thermoplastics v. Faytex I*”). Furthermore, the Federal Circuit “acknowledges that it has in effect recognized . . . product-by-process claims as exceptional.” *Atlantic Thermoplastics v. Faytex I*, 970 F.2d at 847, 23 USPQ2d at 1491.

Because of this exceptional status, the Examiner has carefully reviewed the claims and it is the Examiner’s position that claims 15-21 *do not* contain any product-by-process limitations whether in a conventional format or otherwise. If Applicants disagree with the Examiner, the Examiner respectfully requests Applicants in their next response to expressly point out any product-by-process claim(s) and their limitations so that they may be afforded their exceptional status and treated accordingly. Applicants are reminded that “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself.” *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).¹ Unless expressly noted otherwise by the Examiner, the preceding discussion on product-by-process principles applies to all examined claims currently pending.

¹ See also MPEP §2113.

Response to Arguments

34. Applicants' arguments with respect to claims 15-21 have been considered but are moot in view of the new grounds of rejection.

35. The Examiner notes that Applicants make reference to "the Official Action dated on August 26, 2008" in rebutting the various rejections. However, the previous Office action was mailed on 11 February 2009. The Examiner has assumed that Applicants, when reciting "the Official Action dated on August 26, 2008," are referring to the Office action mailed on 11 February 2009.

Examiner Initiated Interview

36. The Examiner thanks Applicants' representative, Andrew Dunlap, for the courtesies extended to the Examiner during the telephone conversation on 10 August 2009. As discussed in the phone interview, if Applicants positively recite conditional elements B, C, and D (from above) by incorporating these elements in to the *structure* of the system of claim 15-21, then claims 15-21 will be allowed.

Conclusion

37. Applicants' 09 Apr Amendments necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

38. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is

not a matter of right. “The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion.” *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112, 1st paragraph written description and enablement, §112, 2nd paragraph indefiniteness, and §102 and §103, prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

39. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

40. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C.

Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

41. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

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August 10, 2009

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